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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,195	09/26/2005	Michael Baentsch	CH920020034US1	8361
54856	7590	01/02/2009		
LOUIS PAUL HERZBERG 3 CLOVERDALE LANE MONSEY, NY 10952			EXAMINER HENNING, MATTHEW T	
			ART UNIT	PAPER NUMBER
			2431	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/532,195	Applicant(s) BAENTSCH ET AL.	
	Examiner MATTHEW T. HENNING	Art Unit 2431	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1 This action is in response to the communication filed on 4/7/2008.

2 **DETAILED ACTION**

3 Claim 1 has been examined. Claims 2-41 have been cancelled.

4 *Title*

5 The title of the invention is not descriptive. A new title is required that is clearly
6 indicative of the invention to which the claims are directed.

7 *Information Disclosure Statement*

8 The listing of references in the specification is not a proper information disclosure
9 statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information
10 submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be
11 incorporated into the specification but must be submitted in a separate paper." Therefore, unless
12 the references have been cited by the examiner on form PTO-892, they have not been
13 considered.

14 *Drawings*

15 The drawings filed on 4/21/2005 are acceptable for examination proceedings.

16 *Specification*

17 The disclosure is objected to because of the following informalities:

18 The disclosure does not contain section headings, as required by 37 CFR 1.77.

19 Page 5 Line 30 of the specification contains a typographical error ("I an especially").

20 The use of the trademark JAVA has been noted in this application. **It should be**
21 **capitalized wherever it appears and be accompanied by the generic terminology.**

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

The applicants are encouraged to review the specification carefully for any other formal matters which may have been overlooked.

Appropriate correction is required.

Claim Objections

Claim 1 is objected to because of the following informalities: Claim 1 recites the limitation "the new key" in line 29. There is insufficient antecedent basis for this limitation in the claim. While "a new key" does appear in the claim prior to this line, its appearance is in an alternative "path". The examiner believes that line 28 of claim 1 should read "storing the decrypted new key in place of the previous key; and". This is due to the fact that this issue has arisen because previous claims 2 and 3 were moved into independent claim 1, and claim 3 depended from claim 2, but in claim 1 the limitations are in the alternative.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1 Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bushmitch et al
2 (US Patent Application Publication 2002/0159601) hereinafter referred to as Bushmitch, and
3 further in view of Morlang et al. (US Patent Application Publication 2003/0182576) hereinafter
4 referred to as Morlang.

5 Bushmitch disclosed a method for providing a user device with a set of access codes, the
6 method comprising: in the user device, storing an encryption key and an identification code
7 (Bushmitch Paragraphs 0074-0075), and sending a message containing an identification code to
8 a server via a communications network (Bushmitch Paragraph 0074); in the server, storing an
9 encryption key corresponding to the key stored in the user device (Bushmitch Paragraph 0076),
10 allocating the set of access codes on receipt of the identification code from the user device
11 (Bushmitch Paragraph 0075), encrypting the set of access codes using the encryption key to
12 produce an encrypted set (Bushmitch Paragraph 0075), and sending a message containing the
13 encrypted set to the user device via the network (Bushmitch Paragraph 0075); in the user device,
14 decrypting the encrypted set received from the server using the key in storage, and storing the
15 decrypted set of access codes for use by a user of the user device (Bushmitch Paragraph 0054);
16 and, upon the number of unused access codes reaching a predetermined threshold, in the server,
17 sending a message containing a new set of access codes to the user device via the network
18 (Bushmitch Paragraph 0053); in the user device, storing the new set for use by a user of the user
19 device (Bushmitch Paragraph 0053); and selectively: in the user device, tracking the access
20 codes used by the user, generating a request in response to the number of unused access codes
21 reaching a predetermined threshold, and sending a message containing the request to the server;
22 and in the server, sending the message containing the new set of access codes on receipt of the

1 request; or in the server, tracking the access codes used by the user, and sending the message
2 containing the new set of access codes to the user device in response to the number of unused
3 access codes reaching a predetermined threshold (Bushmitch Paragraph 0053); or in the server,
4 generating a new key, encrypting the new key with the previous key, and sending a message
5 containing the encrypted new key to the user device via the network; and, in the user device,
6 decrypting the new key received from the server using the previous key, and storing the
7 decrypted new key in place of the previous key; or in the server, encrypting a new set of access
8 codes with the new key to produce a new key encrypted set, and sending a message containing
9 the new key encrypted set to the user device via the network, and, in the user device, decrypting
10 the new key encrypted set using the new key, and storing the decrypted new set for use by a user
11 of the user device; or in the user device, generating a public/private key pair, and sending a
12 message containing the public key of the pair to the server via the network, in the server,
13 generating a session key, encrypting the set of access codes with the session key to produce a
14 session key encrypted set, encrypting the session key with the public key to produce an
15 encrypted session key, sending a message containing the session key encrypted set and the
16 encrypted session key to the user device via, the network, and, in the user device, decrypting the
17 encrypted session key with the private key of the pair to recover the session key, decrypting the
18 session key encrypted set with the recovered session key to recover the set, and storing the
19 decrypted set for use by a user of the user device. However, Bushmitch did not specifically
20 disclose performing, at the server, a look up function based on the identification code received in
21 the message to retrieve the key from storage.

1 Morlang teaches that in order to protect communications between two nodes, an
2 encryption key can be shared between the nodes, and stored in a table with an associated
3 identifier. Then, in order to establish the encrypted connection, the client can send a message
4 including the session identifier, which the server uses to retrieve the encryption key, and then
5 encrypt the communications (Morlang Paragraphs 0025-0026).

6 It would have been obvious to the ordinary person skilled in the art at the time of
7 invention to have employed the teachings of Morlang in the system of Bushmitch by sending a
8 session identifier from the portable storage device to the gateway in order to allow the gateway
9 to determine a proper pre-shared encryption key. This would have been obvious because the
10 ordinary person skilled in the art would have been motivated to protect the communications
11 between the gateway and the portable storage device.

12 ***Double Patenting***

13 The nonstatutory double patenting rejection is based on a judicially created doctrine
14 grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or
15 improper timewise extension of the “right to exclude” granted by a patent and to prevent possible
16 harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection
17 is appropriate where the conflicting claims are not identical, but at least one examined
18 application claim is not patentably distinct from the reference claim(s) because the examined
19 application claim is either anticipated by, or would have been obvious over, the reference
20 claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re*
21 *Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225
22 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*
23 *Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163
24 USPQ 644 (CCPA 1969).

25 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may
26 be used to overcome an actual or provisional rejection based on a nonstatutory double patenting
27 ground provided the conflicting application or patent either is shown to be commonly owned
28 with this application, or claims an invention made as a result of activities undertaken within the
29 scope of a joint research agreement.

30 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal
31 disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR
32 3.73(b).

1
2 Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double
3 patenting as being unpatentable over claims 1-18, 22-25, 27-30, and 34-39 of copending
4 Application No. 12/125,247. Although the conflicting claims are not identical, they are not
5 patentably distinct from each other because claim 1 recites each combination of the claim set 1-6
6 in the alternative. That is to say, claim 1 of the instant application recites all of claims 2, 3, 4, 5,
7 and 6, each including independent claim 1, in alternative form. As such, claim 1 of the instant
8 application is not patentably distinct from claims 1-6 of application 12/125,247. Furthermore,
9 claims 7-18, 22-25, 27-30, and 34-39, although worded slightly different, correspond to claims 1-
10 6, and are therefore not patentably distinct from claim 1 of the instant application.

11 This is a provisional obviousness-type double patenting rejection because the conflicting
12 claims have not in fact been patented.

14 *Conclusion*

15 Claims 1 have been rejected.

16 The prior art made of record and not relied upon is considered pertinent to applicant's
17 disclosure.

18 Any inquiry concerning this communication or earlier communications from the
19 examiner should be directed to MATTHEW T. HENNING whose telephone number is
20 (571)272-3790. The examiner can normally be reached on M-F 8-4.

21 If attempts to reach the examiner by telephone are unsuccessful, the examiner's
22 supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the
23 organization where this application or proceeding is assigned is 571-273-8300.

1 Information regarding the status of an application may be obtained from the Patent
2 Application Information Retrieval (PAIR) system. Status information for published applications
3 may be obtained from either Private PAIR or Public PAIR. Status information for unpublished
4 applications is available through Private PAIR only. For more information about the PAIR
5 system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR
6 system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would
7 like assistance from a USPTO Customer Service Representative or access to the automated
8 information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

9
10
11 /Matthew T Henning/
12 Examiner, Art Unit 2431
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